

REMARKS

By this Response, Applicant has amended claims 1, 5, 13, 24, 34, 37, 43, and 47-53. No new matter has been added. Claims 1-58 are present in the application. Of those claims, claims 11, 12, and 54-58 have been withdrawn from further consideration on the merits as being directed to non-elected subject matter. Thus, claims 1-10 and 13-53 are pending on the merits. Applicant respectfully requests reconsideration and withdrawal of the claim rejections included in the final Office Action issued May 27, 2010, for at least the reasons outlined in more detail herein.

I. Claim Rejection under 35 U.S.C. § 103(a) based on Golley

Claims 1-10 were rejected under 35 U.S.C. § 103(a) based on U.S. Pat. App. Pub. No. US 2003/0164117 A1 to Golley et al. (“Golley”). Final Office Action at 2. Claims 1 and 5 are the independent claims included in this claim rejection, and although Applicant does not believe this claim rejection is proper for at least the reasons outlined in the Request for Reconsideration filed February 12, 2010, Applicant has amended independent claims 1 and 5 in order to expedite issuance of a Notice of Allowance for the present application. Applicant respectfully submits that Golley fails to render independent claim 1 or independent claim 5, as amended, *prima facie* obvious because Golley fails to disclose or suggest all of the subject matter recited in those claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1 and 5 under 35 U.S.C. § 103(a) based on Golley.

According to the M.P.E.P., in order to establish a *prima facie* case of obviousness, the record must “include[] findings of fact concerning the state of the art and the teachings of the references” Id. § 2141(*II*) (citations omitted). If it is found

that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection “must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” Id. § 2141(III).

A. Amended Independent Claim 1

Amended independent claim 1 is directed to “[a] composition comprising pulverized, spray-dried, hydrous kaolin” Golley does not disclose or render obvious pulverized, spray-dried, hydrous kaolin, and the rejection fails to explain why pulverized, spray-dried, hydrous kaolin would have been obvious to one of ordinary skill in the art. Indeed, the rejection neither asserts that Golley discloses pulverized hydrous kaolin nor asserts that it would have been obvious to one of ordinary skill in the art to pulverize the compositions disclosed in Golley.

According to exemplary embodiments of the present application, the compositions comprising hydrous kaolin are spray-dried and thereafter pulverized so that the spray-dried kaolin has a defined particle size distribution, which facilitates a rapid dispersion in both aqueous and non-aqueous media. (Specification at p. 2, ¶ [020]). For example, in Example 3 dispersion rates of non-pulverized, spray-dried feeds were measured and compared directly to corresponding pulverized, spray-dried samples C and D. (Specification at p. 5, ¶ [0054]). The dispersion rates were measured with a Hegman Grind gauge. Id. As shown in Table VIII, the pulverized, spray-dried samples have higher dispersion rates than the corresponding non-pulverized, spray-dried samples. (Specification at p. 5, ¶ [0055]). Examples 4 and 5 reinforce the results of Example 3. (See Specification at 5, ¶ [0056], through p. 6, ¶ [0061]).

As outlined above, pulverized, spray-dried, hydrous kaolins having a defined particle size distribution exhibit higher dispersion rates than non-pulverized kaolins. Conventional spray-drying processes tend to result in the spray-dried kaolin agglomerating, which tends to reduce the dispersion rates of the composition containing the spray-dried kaolin. Slower dispersion rates may be undesirable when hydrous kaolins are used in, for example, paints, where reducing agglomerate formation is desirable. Higher dispersion rates help reduce agglomerate formation in paints, and thus, pulverized, spray-dried, hydrous kaolins may be desirable for use in products such as paints.

Moreover, the dispersion rate of kaolin tends to be a function of maximum particle size or agglomerate size. Thus, non-pulverized, spray-dried kaolin would not be expected to have the same dispersion rate as pulverized, spray-dried kaolin because the pulverized, spray-dried kaolin would not have the agglomerates still present in a spray-dried kaolin that had not been pulverized, such as the spray-dried kaolin disclosed in Golley. Applicant also notes that when the particle size distribution of kaolin is measured using a Sedigraph, the kaolin is fully dispersed, and thus, the presence of agglomerates in the spray-dried kaolin of Golley would not be reflected in its particle size distribution characteristics, even though it would be expected to have agglomerates due to spray-drying. As a result, the dispersion rate of the spray-dried kaolin of Golley, which has not been pulverized, cannot be expected to be the same as the dispersion rate of the pulverized, spray-dried kaolin set forth in independent claim 1.

Simply stated, Golley does not disclose pulverized, spray-dried, hydrous kaolins. Moreover, although Golley mentions spray-drying (p. 4, ¶ [0067]), Golley does not

disclose pulverizing the spray-dried composition to achieve rapid dispersion of the spray-dried kaolin.

In the “Response to Arguments” section, the Examiner mischaracterizes Applicant’s remarks included in the Request for Reconsideration. In particular, the Examiner asserts that Applicant argued “that pulverized hydrous kaolins having a defined particle distribution may exhibit higher dispersion rates than non-pulverized kaolins.” Final Office Action at 7. Based on this characterization of Applicant’s remarks, the Examiner asserts that “the features on which applicant relies (i.e., higher dispersion ratio) are not recited in the rejected claim(s).” Id. at 7-8.

Contrary to the Examiner’s assertions, Applicant distinguished the claims from Golley by noting that Golley fails to disclose pulverized kaolin. In addition to noting that Golley does not disclose pulverized kaolin, Applicant also pointed out that it would not have been obvious to pulverize the kaolin disclosed in Golley because Golley does not disclose concern for dispersion rates. Thus, rather than arguing that Golley fails to disclose higher dispersion rates, as asserted by the Examiner, Applicant pointed out that Golley fails to disclose pulverized kaolin, which is recited in independent claim 1, and further, that it would not have been obvious to pulverize the un-pulverized kaolin disclosed in Golley.

For at least the above-outlined reasons, independent claim 1 is not *prima facie* obvious based on Golley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 1 based on Golley. Claims 2-4 depend from independent claim 1. Thus, claims 2-4 are patentably distinguishable from Golley for at least the same reasons as independent claim 1, and

Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims based on Golley.

B. Amended Independent Claim 5

Amended independent claim 5 is direct to “[a] composition comprising pulverized, spray-dried, hydrous kaolin, wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” Golley does not disclose at least this subject matter recited in amended independent claim 5. Indeed, the rejection statement neither asserts that Golley discloses such a pulverized hydrous kaolin nor asserts that it would have been obvious to one of ordinary skill in the art to modify the compositions disclosed in Golley to have the recited Hegman grind.

In the “Response to Arguments” section, the Examiner implicitly acknowledges that Golley fails to disclose a hydrous kaolin having “a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test,” as recited in independent claim 5. See Final Office Action at 8 (failing to explain how Golley discloses this subject matter). However, the Examiner asserts that when a reference discloses all of the limitations of a claim, except a property or function, the Examiner may presume that the property or function is inherent. Id. (citing M.P.E.P. §§ 2112-2112.02).

As noted above, Golley does not disclose pulverized, spray-dried, hydrous kaolin. Thus, it is improper to presume that the Hegman grind characteristic recited in independent claim 5 is inherently present in the kaolin disclosed in Golley. Indeed, pulverizing spray-dried kaolin removes agglomerates, which, in turn, results in more rapid dispersion. The Hegman grind correlates to rate of dispersion. Thus, because the kaolin in Golley is not pulverized, it would not be expected to have the same Hegman

grind characteristic as the hydrous kaolin set forth in independent claim 5, which is pulverized.

For at least these reasons, independent claim 5 is not *prima facie* obvious based on Golley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 5 based on Golley. Claims 6-10 depend from independent claim 5. Thus, claims 6-10 are patentably distinguishable from Golley for at least the same reasons as independent claim 5, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims based on Golley.

II. Claim Rejection under 35 U.S.C. § 103(a) based on Golley and Pavlin

Claims 13-23 and 47 were rejected under 35 U.S.C. § 103(a) based on Golley in combination with U.S. Patent No. 4,711,927 to Pavlin et al. ("Pavlin"). Final Office Action at 4. Claims 13 and 47 are the independent claims included in this claim rejection, and although Applicant does not believe this claim rejection is proper for at least the reasons outlined in the Request for Reconsideration, Applicant has amended independent claims 13 and 47 in order to expedite issuance of a Notice of Allowance for the present application. Applicant respectfully submits that Golley and Pavlin fail to render independent claim 13 or independent claim 47, as amended, *prima facie* obvious because Golley and Pavlin fail to disclose or suggest all of the subject matter recited in those claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 13 and 47 under 35 U.S.C. § 103(a) based on Golley and Pavlin.

A. Amended Independent Claim 13

Amended independent claim 13 is directed to “[a]n ink comprising . . . pulverized, spray-dried, hydrous kaolin, wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” As outlined above with respect to the rejection of independent claim 5, Golley does not disclose at least this subject matter recited in independent claim 13. Pavlin fails to overcome the above-noted deficiencies of the rejection of independent claim 5.

For at least these reasons, independent claim 13 is not *prima facie* obvious based on Golley and Pavlin. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 13 based on Golley and Pavlin. Claims 14-23 depend from independent claim 13. Thus, claims 14-23 are patentably distinguishable from Golley and Pavlin for at least the same reasons as independent claim 13, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims.

B. Amended Independent Claim 47

Amended independent claim 47 is directed to “[a]n ink comprising . . . pulverized, spray-dried, hydrous kaolin” For the reasons outlined above with respect to independent claim 1, Golley does not disclose pulverized, spray-dried, hydrous kaolin. Pavlin also fails to disclose pulverized, spray-dried, hydrous kaolin.

For at least the above-outlined reasons, independent claim 47 is not *prima facie* obvious based on Golley and Pavlin, regardless of whether those references are viewed individually or as a whole. Therefore, Applicant respectfully requests reconsideration

and withdrawal of the § 103(a) rejection of independent claim 47 based on Golley and Paylin.

III. Claim Rejection under 35 U.S.C. § 103(a) based on Golley and Sare

Claims 24-33, 48, and 51 were rejected under 35 U.S.C. § 103(a) based on Golley in combination with U.S. Pat. App. Pub. No. US 2002/0088376 A1 to Sare et al. (“Sare”). Final Office Action at 5. Claims 24, 48, and 51 are the independent claims included in this claim rejection, and although Applicant does not believe this claim rejection is proper for at least the reasons outlined in the Request for Reconsideration, Applicant has amended independent claims 24, 48, and 51 in order to expedite issuance of a Notice of Allowance for the present application. Applicant respectfully submits that Golley and Sare fail to render independent claim 24, 48, or 51, as amended, *prima facie* obvious because Golley and Sare fail to disclose or suggest all of the subject matter recited in those claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 24, 48, and 51 under 35 U.S.C. § 103(a) based on Golley and Sare.

A. Amended Independent Claim 24

Amended independent claim 24 is directed to “[a] paint comprising . . . pulverized, spray-dried, hydrous kaolin, wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” For at least the reasons outlined above with respect to independent claim 5, Golley fails to disclose or render obvious at least this subject matter recited in independent claim 24. Sare fails to overcome the above-noted deficiencies of the rejection of independent claim 5 based on Golley. For at least these reasons, independent claim 24 is not *prima*

facie obvious based on Golley and Sare. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 24 based on Golley and Sare. Claims 25-33 depend from independent claim 24. Thus, claims 25-33 are patentably distinguishable from Golley and Sare for at least the same reasons as independent claim 24, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims.

B. Amended Independent Claim 48

Amended independent claim 48 is directed “[a] paint comprising . . . pulverized, spray-dried, hydrous kaolin” For the reasons outlined above with respect to independent claim 1, Golley does not disclose at least this subject matter recited in independent claim 48. Sare fails to overcome the above-noted deficiencies of the rejection of independent claim 1 based on Golley. For at least these reasons, independent claim 48 is not *prima facie* obvious based on Golley and Sare. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 48 based on Golley and Sare.

C. Amended Independent Claim 51

Amended independent claim 51 is directed to “[a] coating comprising pulverized, spray-dried, hydrous kaolin” For the reasons outlined above with respect to independent claim 1, Golley does not disclose at least this subject matter recited in independent claim 51. Sare fails to overcome the above-noted deficiencies of the rejection of independent claim 1 based on Golley. For at least these reasons, independent claim 51 is not *prima facie* obvious based on Golley and Sare. Therefore,

Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 51 based on Golley and Sare.

IV. Claim Rejection under 35 U.S.C. § 103(a) based on Golley and Pruett

Claims 34-36 and 49-53 were rejected under 35 U.S.C. § 103(a) based on Golley in combination with U.S. Patent No. 6,564,199 to Pruett et al. (“Pruett”). Final Office Action at 6. Claims 34, 37, 43, and 49-53 are the independent claims included in this claim rejection, and although Applicant does not believe this claim rejection is proper for at least the reasons outlined in the Request for Reconsideration, Applicant has amended independent claims 34, 37, 43, and 49-53 in order to expedite issuance of a Notice of Allowance for the present application. Applicant respectfully submits that Golley and Pruett fail to render independent claims 34, 37, 43, and 49-53, as amended, *prima facie* obvious because Golley and Pruett fail to disclose or suggest all of the subject matter recited in those claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 34, 37, 43, and 49-53 under 35 U.S.C. § 103(a) based on Golley and Pruett.

A. Amended Independent Claims 34, 37, and 43

Amended independent claims 34, 37, and 43 are directed to “[a] polymer product comprising pulverized, spray-dried, hydrous kaolin,” “[a] rubber product comprising pulverized, spray-dried, hydrous kaolin,” and “[a] coating comprising pulverized, spray-dried, hydrous kaolin,” respectively, “wherein the hydrous kaolin has . . . a Hegman grind of more than about 2 in 3 minutes using ‘SSM’ V-T Alkyd Hegman Test.” For at least the reasons outlined above with respect to independent claim 5, Golley fails to disclose or render obvious at least this subject matter recited in independent claims 34,

37, and 43. Pruett fails to overcome the above-noted deficiencies of the rejection of independent claim 5 based on Golley. For at least these reasons, independent claims 34, 37, and 43 are not *prima facie* obvious based on Golley and Pruett. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claims 34, 37, and 43 based on Golley and Pruett. Claims 35, 36, 38-42, and 44-46 depend from a corresponding one of independent claims 34, 37, and 43. Thus, claims 35, 36, 38-42, and 44-46 are patentably distinguishable from Golley and Pruett for at least the same reasons as independent claims 34, 37, and 43, and Applicant respectfully requests reconsideration and withdrawal of the rejection of those claims based on Golley and Pruett.

B. Amended Independent Claims 49-53

Amended independent claims 49-53 are directed to “[a] polymer product,” “[a] rubber product,” “[a] coating,” “[a] paper coating,” and “[a] paperboard coating,” respectively, each “comprising pulverized, spray-dried, hydrous kaolin” For the reasons outlined above with respect to independent claim 1, Golley does not disclose pulverized, spray-dried, hydrous kaolin. Pruett fails to overcome the above-noted deficiencies of the rejection of independent claim 1 based on Golley. For at least these reasons, independent claims 49-53 are not *prima facie* obvious based on Golley and Pruett. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claims 49-53 based on Golley and Pruett.

V. Conclusion

For at least the above-outlined reasons, pending claims 1-10 and 13-53 should be allowable. Accordingly, Applicant respectfully requests reconsideration of this

application, withdrawal of the claim rejections, and allowance of all of claims 1-10 and 13-53.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

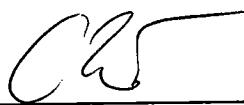
Applicant respectfully submits that the final Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,
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Dated: October 27, 2010

By: _____


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